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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,142	11/28/2005	William J. Murphy	JJK-0202 (P1998J0118A)	6506

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EXAMINER

MCAVOY, ELLEN M

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/532,142

Applicant(s)

MURPHY ET AL.

Examiner

Ellen M. McAvoy

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20 April 2005</u> . | 6) <input type="checkbox"/> Other: ____. |

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 11-17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/532,143. Although the conflicting claims are not identical, they are not patentably distinct from each other because the methods of hydroisomerizing a waxy feed appear to be the same since the unitized mixed powdered pellet catalyst may be the same.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy et al (6,620,312).

Murphy et al ["Murphy"] discloses a method for producing a lube basestock from a waxy feed. The feed is hydrotreated to lower the nitrogen and sulfur content, hydroisomerized to reduce the wax content, and then hydrocatalytically dewaxed. The hydrocatalytic dewaxing step uses a unitized mixed powder catalyst which can be prepared from a wide variety of individual dewaxing and isomerization catalysts. The dewaxing catalyst is a 10 member ring unidirectional inorganic oxide molecular sieve impregnated with from 0.1 to 3 wt.% of at least one Group VIII metal, preferably platinum or palladium. Suitable 10 member ring unidirectional inorganic oxide molecular sieves include zeolites ZSM-22, ZSM-23, ZSM-35 and ZSM-48. The isomerization catalyst component comprises a porous refractory metal oxide support such as alumina, silica-alumina, titania, zirconia, etc., which contains an additional catalytic component including Group VIII metals, preferably platinum and palladium, present in an amount of 0.1 to 5 wt. %, and optionally including a promoter or dopant such as yttria or magnesia. This meets the limitations of (i) the first dewaxing component, and (ii) the second isomerization component of the claims. Independent method claims 1 and 10 differ by including step (iii) which sets forth a ratio of the

first and second components. Although not taught in Murphy, the examiner is of the position that any ratio of components (i) and (ii) may be used in the process of the prior art since the method of hydrosomerating a waxy feed to produce a lube basestock is the same.

Method claim 11 differs by using a unitized mixed powdered pellet catalyst comprising both the (i) first component and (ii) the second component being selected from 8, 10 and 12 ring molecular sieves, and mixtures thereof, having a metal hydrogenation component dispersed thereon. However, as set forth above, Murphy teaches as the dewaxing catalyst a 10 member ring unidirectional inorganic oxide molecular sieve impregnated with from 0.1 to 3 wt.% of at least one Group VIII metal, preferably platinum or palladium. Suitable 10 member ring unidirectional inorganic oxide molecular sieves include zeolites ZSM-22, ZSM-23, ZSM-35 and ZSM-48. Murphy teaches that the unitized powdered catalysts comprise a mixture of individual, different and distinct catalyst components. See column 4, lines 56-65. Thus the examiner is of the position that Murphy meets the limitations of both components (i) and (ii) set forth in method claim 11. The claim differs by including step (iii) which sets forth a ratio of the first and second components. Although not taught in Murphy, the examiner is of the position that any ratio of components (i) and (ii) may be used in the process of the prior art since the method of hydrosomerating a waxy feed to produce a lube basestock is the same.

Claim Rejections - 35 USC § 103

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandes et al (5,723,716), Brandes et al (5,770,542) and Brandes et al (5,977,425).

The Brandes et al references ["Brandes"] disclose methods of upgrading waxy feeds using a catalyst comprising mixed powdered dewaxing catalyst and powdered isomerization catalyst formed into discrete particles. The dewaxing catalyst is a 10 member ring unidirectional inorganic oxide molecular sieve impregnated with from 0.1 to 5 wt.% of at least one Group VIII metal, preferably platinum or palladium. Suitable 10 member ring unidirectional zeolites include ZSM-22, ZSM-23, ZSM-35 and ZSM-48. The isomerization catalyst component comprises a refractory metal oxide support base such as alumina, silica-alumina, zirconia, etc., which contains an additional catalytic component including Group VIII metals, preferably platinum and palladium, present in an amount of 0.1 to 5 wt. %, and optionally including a promoter or dopant such as yttria or magnesia. This meets the limitations of (i) the first dewaxing component, and (ii) the second isomerization component of the claims. Independent method claims 1 and 10 differ by including step (iii) which sets forth a ratio of the first and second components. Although not taught in the Brandes patents, the examiner is of the position that any ratio of components (i) and (ii) may be used in the process of the prior art since the method of hydriomerating a waxy feed to produce a lube basestock is the same.

Method claim 11 differs by using a unitized mixed powdered pellet catalyst comprising both the (i) first component and (ii) the second component being selected from 8, 10 and 12 ring molecular sieves, and mixtures thereof, having a metal hydrogenation component dispersed thereon. However, as set forth above, the Brandes patents teach as the dewaxing catalyst a 10 member ring unidirectional inorganic oxide molecular sieve impregnated with from 0.1 to 3 wt.% of at least one Group VIII metal, preferably platinum or palladium. Suitable 10 member

ring unidirectional inorganic oxide molecular sieves include zeolites ZSM-22, ZSM-23, ZSM-35 and ZSM-48. Brandes teaches that the unitized powdered catalysts comprise a mixture of individual, different and distinct catalyst components. Thus the examiner is of the position that the Brandes patents meet the limitations of both components (i) and (ii) set forth in method claim 11. The claim differs by including step (iii) which sets forth a ratio of the first and second components. Although not taught in the Brandes patents, the examiner is of the position that any ratio of components (i) and (ii) may be used in the process of the prior art since the method of hydrosomerating a waxy feed to produce a lube basestock is the same.

Conclusion

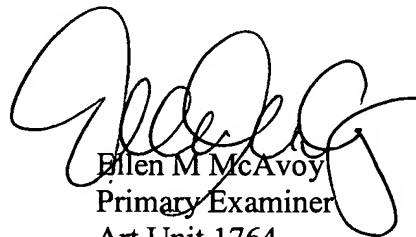
The prior art made of record and not relied upon is considered pertinent to applicants' disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M. McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ellen M. McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
June 7, 2006